

ATTORNEY DOCKET: AUS920010294US1

PATENT

Section III: REMARKS

It is respectfully requested that the changes as noted above in Section I be made to the present application.

In the above-referenced Office Action which was mailed on 4/8/2005, prosecution of the present application was re-opened following the filing of an appeal brief on 1/7/2005.

In the Office Action, claims 1, 7-9, 18, 24-26 and 29 were rejected under 35 USC 112, first paragraph, as failing to comply with the enablement requirement. It was alleged that it was beyond the skill level of one of ordinary skill in the art to implement a display feature on a telephone. That rejection is respectfully traversed and it is applicant's belief that implementing a display feature on a phone was well within the state of the art and the skill level of one of ordinary skill in the art. As stated in the application, details of the illustrated exemplary embodiments which are generally known in the art are not re-illustrated in the application beyond those shown and described in the application in order not to obfuscate or distract from the teachings of the present invention.

Furthermore, the present amendment amends the claims to clarify that the second phone number is that of a user wireless device and the display is presented on that device. Thus it is respectfully submitted that the rejection of claims 1, 7-9, 18, 24-26 and 29 under 35 USC 112, first paragraph, as failing to comply with the enablement requirement is without merit and, in any event, is now moot with the amendments made herein. Thus it is believed that claims 1, 7-9, 18, 24-26 and 29, as herein amended, are allowable under 35 USC 112, first paragraph.

ATTORNEY DOCKET: AUS920010294US1

PATENT

Next, claims 1, 18 and 29 were rejected under 35 USC 112, second paragraph, as being indefinite because the terms "forwarding/forwarded" and "transferred" are used in the same context although those are terms of art in telephony and refer to different features/operations. That rejection is respectfully traversed. However, the above noted claims have herein been amended to substitute the term "forwarded" for the term "transferred" thereby obviating the stated rejection of claims 1, 18 and 29. Thus, as herein amended, claims 1, 18 and 29, as herein amended, are submitted to be allowable under 35 USC 112, second paragraph.

Next, claims 1-35 were rejected under 35 USC 103(a) as being unpatentable over Tatchell et al (U.S. Patent 6,160,877, hereinafter "Tatchell") in view of Rogers et al (U.S. Patent 5,946,386, hereinafter "Rogers") or, in the alternative, in view of the newly cited Creamer et al reference (U.S. Patent 6,028,917, hereinafter referred to as "Creamer"). The above noted rejections are respectfully traversed. However, in order to further the prosecution of the present application, and without waiving any of applicant's rights to argue the allowability of the originally presented claims in a subsequent appeal or other proceeding in the event that the Examiner does not concur that the present amendment places the application in condition for allowance, applicant has herein amended the claims to clarify the claimed combinations and place the claims in condition for allowance.

It is noted that the present application includes claims 1-35 with claims 1, 18 and 29 being independent claims, claims 2-17 being ultimately dependent from method claim 1, claims 19-28 being ultimately dependent from medium claim 18 and claims 30-35 being ultimately dependent from system claim 29. Applicant has

ATTORNEY DOCKET: AUS920010294US1

PATENT

herein cancelled claims 12 and 30, without prejudice, with the belief that the substance of those claims is included in one or more of the remaining claims. Applicant has amended all of the independent claims 1, 18 and 29 to include additional recitations to clearly distinguish claims 1, 18 and 29, as well as the remaining dependent claims 2-11, 13-17, 19-28 and 31-35, respectively, which include all of the limitations of one of the independent claims, from the cited references. As herein amended, claims 1-11, 13-29 and 31-35 are believed to be in condition for allowance over the cited references.

More specifically, Tatchell discloses a method of screening and prioritizing an incoming call which is enabled by a subscriber using voice commands. Tatchell does not disclose, teach or even suggest the use of a visual display on a user device to enable entering and confirming the numbers of incoming calls to be forwarded and the forwarding number to which the incoming calls are sent. As noted by the Examiner on page 6 of the First Office Action, "... long lists of messages or intricate menus ... could be tedious and confusing to navigate via telephone key buttons or via voice." The present invention overcomes this shortcoming by enabling a user to provide call forwarding input to a user device and to complete the input with a positive key entry after visually confirming the input on a display associated with the user device. The use of a user device having a display capability would be directly against the teachings of Tatchell so it cannot be said that it is obvious from Tatchell to use a display device for entering call forwarding information. If anything, Tatchell teaches away from the present invention by disclosing only a voice-activated system and not mentioning even a possible function in his system for a display device or positive user inputs and visual confirmation of the user inputs. Indeed, it is submitted that the insertion of a display function in the

ATTORNEY DOCKET: AUS920010294US1

PATENT

Tatchell system would render the Tatchell system inoperable for its intended purpose. Thus, even a combination of Tatchell with another reference having a display function would not be appropriate since it would be against the express teachings of Tatchell and clearly not even suggested by Tatchell.

Moreover, Tatchell does not teach or suggest a method for enabling a user to forward only selected incoming telephone calls from a first number to a second number, with the second number being a number of a user wireless device, by enabling user input to the user wireless device to identify selected source phone numbers from which incoming telephone calls may be placed to the first number, and displaying the selected source phone numbers on the user wireless device and enabling the user to input the second number to the user wireless device and displaying the second number on said user wireless device, and then enabling the user to provide an input to accept the second number and the selected source phone numbers whereby only incoming telephone calls to the first number from the identified selected source phone numbers are forwarded from the first number to the second number.

Rogers discloses a call management system which enables users to manage calls directly **from their workstation computers**. This is also directly against the teachings of the present invention in which users, **from their wireless device**, may select only certain numbers to have forwarded from a first number (e.g. office number or the number of another wireless device) to the designated number ("second number") of the user's wireless device. Thus even a combination of Tatchell and Rogers falls short of even suggesting a method for enabling a user to forward only selected incoming telephone calls from a first number to a second number, with the second number being a number of a user wireless device,

ATTORNEY DOCKET: AUS920010294US1

PATENT

by enabling user input to the user wireless device to identify selected source phone numbers from which incoming telephone calls may be placed to the first number, and displaying the selected source phone numbers on the user wireless device and enabling the user to input the second number to the user wireless device and displaying the second number on said user wireless device, and then enabling the user to provide an input to accept the second number and the selected source phone numbers whereby only incoming telephone calls to the first number from the identified selected source phone numbers are forwarded from the first number to the second number, as is clearly set forth in the amended claims.

The newly cited Creamer reference discloses the use of the Internet servers to provide extended telephone services to wired phone users. This is also directly against the teachings of the present invention in which users, **from their wireless device**, may select only certain numbers to have forwarded from a first number (e.g. office number or the number of another wireless device) to the designated number ("second number") of the user's wireless device. Thus even a combination of Tatchell and Creamer falls short of even suggesting a method for enabling a user to forward only selected incoming telephone calls from a first number to a second number, with the second number being a number of a user wireless device, by enabling user input to the user wireless device to identify selected source phone numbers from which incoming telephone calls may be placed to the first number, and displaying the selected source phone numbers on the user wireless device and enabling the user to input the second number to the user wireless device and displaying the second number on said user wireless device, and then enabling the user to provide an input to accept the second number and the selected source phone numbers whereby only incoming telephone calls to the first number

ATTORNEY DOCKET: AUS920010294US1

PATENT

from the identified selected source phone numbers are forwarded from the first number to the second number, as is clearly set forth in the amended claims.

In view of the above-noted distinctions between the present invention and the cited Tatchell, Rogers and Creamer references, all of the independent claims, 1, 18 and 29, have herein been amended to include enabling a user to forward only selected incoming telephone calls from a first number to a second number, with the **second number being a number of a user wireless device**, by enabling **user input to the user wireless device to identify selected source phone numbers** from which incoming telephone calls may be placed to the first number, and **displaying the selected source phone numbers on the user wireless device** and enabling the user to **input the second number to the user wireless device and displaying the second number on said user wireless device**, and then enabling the **user to provide an input to accept the second number and the selected source phone numbers** whereby only incoming telephone calls to the first number from the identified selected source phone numbers are forwarded from the first number to the second number. Since, none of the cited references discloses or even suggests the use of a visual or display interface on a user wireless device as recited in the amended claims, it is submitted that independent claims 1, 18 and 29 are allowable under 35 USC 103(a) over Tatchell in view of Rogers and even alternatively in view of Creamer. Furthermore, since the remaining claims 2-11, 13-17, 19-28 and 31-35 depend from one of claims 1, 18 and 29, and include even further limitations as set forth in the individual claims, it is submitted that claims 2-11, 13-17, 19-28 and 31-35, in addition to claims 1, 18 and 29, are allowable under 35 USC 103(a) over Tatchell in view of Rogers, or Tatchell in view of Creamer or even Tatchell in view of both Rogers and Creamer.

ATTORNEY DOCKET: AUS920010294US1

PATENT

It is noted that the use of visual menu displays verses the use of exclusively verbal input commands is merely a "design choice". In that regard it is submitted that all choices in configuring a unique and inventive combination may be considered design choices but there is no statutory authority to support the rejection of claims merely because design choices were made in forming a total combination of elements and operating relationships among those elements. In fact, it may be more accurate to state that a claimed combination is truly unique and inventive because design choices were made to provide a **combination of elements and relationships** which have not been disclosed in the prior art. This is surely the case with the present application where the cited Tatchell reference, although very extensive and complete, makes no mention of a "design choice" by which a **user wireless device with a display function** may be substituted for his verbal input system. As hereinbefore noted, the displayed input function as disclosed in the present application enables visual confirmation of input before executing on the input. This is not taught or even suggested by Tatchell who discloses only a voice activated system without **visual confirmation of user input**.

Thus, it is submitted that claims 1-11, 13-29 and 31-35, as herein presented, are believed to be in condition for allowance, an early notice of which is hereby requested. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting the allowance of this application, or if the present application is determined to be allowable but for the submission of a Terminal Disclaimer, the Examiner is invited to contact the undersigned at the telephone number indicated below. The

ATTORNEY DOCKET: AUS920010294US1

PATENT

Examiner's attention to this matter is greatly appreciated.

Respectfully submitted,

Robert V. Wilder

Robert V. Wilder (Tel: 512-246-8555)
Registration No. 26,352
Attorney for Applicants
4235 Kingsburg Drive
Round Rock, Texas 78681

Page 16 of 16